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In re Application of:	:	
HESS, Christopher, et al.	:	
U.S. Application No.: 10/595,384	:	DECISION ON PETITION UNDER
PCT No.: PCT/US2004/013483	:	37 CFR 1.47(a)
International Filing Date: 30 April 2004	:	
Priority Date: 15 October 2003	:	
Atty's Docket No.: D5116-00051	:	
For: METHOD AND CONFIGURATION	:	
FOR CONNECTING TEST	:	
STRUCTURES OR LINE ARRAYS	:	
FOR MONITORING INTEGRATED	:	
CIRCUIT MANUFACTURING	:	

This decision is issued in response to applicants' "Petition By Joint Inventor Filing On Behalf Of Other Joint Inventor Who Cannot Be Located (37 CFR 1.47(a))" filed 30 June 2008. Applicants have paid the required \$200 petition fee.

BACKGROUND

On 30 April 2004, applicants filed international application PCT/US2004/013483. The international application claimed a priority date of 15 October 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 15 April 2006.

On 13 April 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 28 January 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an executed oath or declaration in compliance with 37 CFR 1.497.

On 30 June 2008, applicants filed the petition considered herein (with required extension fee). The petition requests acceptance of the declaration without the signature of non-signing inventor David GOLDMAN, whom applicants assert cannot be located after diligent effort.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by one of the two inventors of record, and the declaration includes an unsigned signature block for the non-signing inventor, David GOLDMAN. The declaration includes an additional page which the co-operating inventor expressly executes on behalf of the non-signing inventor. This declaration can be accepted as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), applicants assert that the non-signing inventor cannot be located. MPEP section 409.03(d) sets forth the requirements for showing that an inventor cannot be reached after diligent effort as follows:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. [...]

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Applicants here have provided a statement of Steven E. Koffs, with supporting documents, describing the efforts made to locate the non-signing inventor. This statement provides evidence that applicants have attempted to contact the inventor at his last known address (which is no longer current), and that applicants unsuccessfully attempted to obtain a current address for the inventor from his former employer and through a restricted internet search.

The efforts described by applicants are too limited to demonstrate a diligent effort to locate the non-signing inventor. Specifically, applicants' efforts, as exemplified by the internet search, were limited to Las Vegas, Nevada, the inventor's former city of residence. Applicants must provide a proper showing that a diligent search for the inventor that extends beyond the limits of Las Vegas has been undertaken, and that such a search has failed to identify a current address for the inventor, before item (4) of a grantable petition can be considered satisfied. Applicants should note that, any subsequent showing with respect to a diligent search should include, but not be limited to, a broader internet search for the inventor, with the results of such a search being made of record herein.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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